

REMARKS

Claims 1-20 are pending in the present application. In the Office Action, the Examiner indicated that claims 1-8, 15-18, and 20 are allowed. The Examiner objected to claims 11-14 as being dependent upon a rejected base claim but indicated that these claims would be allowable if rewritten in independent form. Applicants have rewritten claim 11 in independent form including all the limitations of the base claim. Applicants respectfully submit that claims 11-14 are in condition for allowance and request that the Examiner's objections to these claims be withdrawn.

In the Office Action, claims 9-10 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Malmgren, et al (U.S. Patent No. 6,807,154). Claim 19 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Malmgren. The Examiner's rejections are respectfully traversed.

Malmgren describes frame structures that allow radio cell adaptation parameters to be transmitted on a control channel. The radio cell adaptation parameters may include indicators of physical layer (PHY) parameters. However, Malmgren does not describe or suggest decoding control codes at a physical layer, as set forth in independent claims 9, 15, and 18. Malmgren is also completely silent with regard to decrypting control codes and, in particular, decrypting control codes at the physical layer, as set forth in claims 19-20.

In response to the preceding argument, the Examiner alleges that decoding control codes at the physical layer is inherent in Malmgren. Applicants respectfully disagree. Inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Levy*, 17 U.S.P.Q.2d (BNA) at 1463-64; *Skinner*, at 1789; *In re King*, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986). It is not enough

that a reference could have, should have, or would have been used as the claimed invention. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Oelrich*, at 326, quoting *Hansgirg v. Kemmer*, 40 U.S.P.Q. (BNA) 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. Applicants submit that the control codes described in Malmgren do not necessarily need to be decoded at a physical layer. To the contrary, the conventional practice is to decode the control codes at a protocol layer. For example, in a GSM system, control codes are decoded at the protocol layer. See Patent Application, page 5, ll. 22-25. Accordingly, Applicants submit that Malmgren does not inherently describe or suggest decoding control codes at a physical layer.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not anticipated by Malmgren and request that the Examiner's rejections of claims 9-10 under 35 U.S.C. 102(e) be withdrawn.

Moreover, Applicants respectfully submit that the present invention is not obvious over Malmgren. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Rayka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573

(Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Claim 19 depends from independent claim 9. As discussed above, Malmgren does not describe or suggest decoding control codes at a physical layer, as set forth in independent claim 9. Moreover, Malmgren is completely silent with regard to operations that may be carried out at a physical layer and/or a protocol layer. In particular, Malmgren is not concerned with the security risks that may be posed by allowing the protocol layer to decode and/or control the operating parameters of the physical layer. Thus, Malmgren provides no suggestion or motivation for decoding control codes at the physical layer.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not obvious over Malmgren and request that the Examiner's rejection of claim 19 under 35 U.S.C. 103(a) be withdrawn.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date:

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